

(Practitioner's Docket No. IN-5506/BC1-0066)

**REMARKS**

Claim 1 has been amended per the Examiner's suggestions so that the claim no longer recites "(I) constituents containing --, in a weight ratio from 50:1 to 1:50." Further, claim 1 has been amended to provide antecedent basis previously present in the deleted text. No new matter has been entered in this amendment as support can be found in claim 1 and claim 3 as originally filed. Claims 15 and 20 have been amended to include the word "curable" to describe the clearcoat. No new matter has been added with this amendment as support can be found in page 65, lines 16-23 of the original Specification. Entry of these amendments after final is respectfully requested. The amendments place the application in a better condition for allowance and in a better condition for appeal.

1. **Rejection claims 1, 2, 4-8, 14, 15 and 18-20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The PTO states:

"Amended claim 1 is confusing since applicant adds a proviso, 'comprises solid particles in a liquid, and the constituents containing the functional groups (A) and the constituents containing the functional groups (B) are present together in the solid particles, but claim 1 still recites "(I) constituents containing --, in a weight ratio of from 50:1 to 1:50" being directed to separate particles of (A) and (B). Claim 4 reciting different particles improperly broadens the scope of claim 1. The recited sections iii-vi (functional groups A and B present separately) also improperly broadens the scope of claim 1."

(Office Action of 3/3/2006, page 2)

Applicants appreciate the PTO's detailed basis for rejection, but respectfully request reconsideration in light of the amendment to claim 1.

Claim 1 has been amended per the Examiner's comments. Specifically, claim 1 has been amended so that it no longer recites "(I) constituents containing --, in a weight ratio from 50:1 to 1:50." The Examiner has previously indicated that a claim containing that included all the limitations of amended independent

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claim 1 would be allowable over the prior art (See Office Action of 5/25/2005, page 3),

Therefore, reconsideration and removal of the rejection to claims 1 and all claims dependant thereon is respectfully requested.

2. **Rejection of claims 15 and 20 under 35 U.S.C. §103(a) as being unpatentable over Williams et al., U.S. 5,379,947, hereafter "Williams" or "947".**

The PTO has indicated that:

"A clearcoat is a cured coating and thus the presence of functional groups A and B in the same powder or separate powder is immaterial since said powder melt and react together during coating (or curing)"

(Office Action of 3/3/2006, page 3)

Applicants appreciate the PTO's detailed basis for the rejection, but respectfully request reconsideration in light of the amendments to claims 15 and claim 20.

The PTO's rejection seems to be based on the fact that after curing, having functional groups on separate powder is immaterial. Applicants amended claim 15 and claim 20 so that both claims require a curable clearcoat (i.e., a clearcoat that can be cured.) In other words, claims 15 and 20 require a clearcoat having powder that has not reacted or melted together. Since claims 15 and 20 require powder that has not reacted or melted together it is material whether A and B are in the same powder or in different powders.

Further, the uncured powder clearcoat material of claim 15 and claim 20 are dependant on claim 1. Therefore, claims 15 and 20 include all the limitations of claim 1. Since claim 1, as amended, is allowable for reasons indicated in section 1 above herein incorporated by reference and since the uncured powder contains the structural limitations of claim 1, it is respectfully submitted that claims 15 and 20 are allowable over the prior art.

Reconsideration and removal of the anticipation rejection of claims 15 and 20 is respectfully requested in view of the foregoing amendments and remarks.

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3. **Rejection of claims 15 and 20 under 35 U.S.C. §103(a) as being unpatentable over EP 0 844 286, hereafter "286".**

The PTO has indicated that:

"A clearcoat is a cured coating and thus the presence of functional groups A and B in the same powder or separate powder is immaterial since said powder melt and react together during coating (or curing)"

(Office Action of 3/3/2006, page 3)

Applicants appreciate the PTO's detailed basis for the rejection, but respectfully request reconsideration in light of the amendments to claim 15 and claim 20.

The PTO's rejection seems to be based on the fact that after curing, having functional groups on separate powder is immaterial. Applicants amended claim 15 and claim 20 so that both claims require a curable clearcoat (i.e., a clearcoat that can be cured.) In other words, claims 15 and 20 require a clearcoat having powder that has not reacted or melted together. Since claims 15 and 20 require powder that has not reacted or melted together it is material whether A and B are in the same powder or in different powders.

Further, the uncured powder clearcoat material of claim 15 and claim 20 are dependant on claim 1. Therefore, claims 15 and 20 include all the limitations of claim 1. Since claim 1, as amended, is allowable for reasons indicated in section 1 above herein incorporated by reference and since the uncured powder contains the structural limitations of claim 1, it is respectfully submitted that claims 15 and 20 are allowable over the prior art.

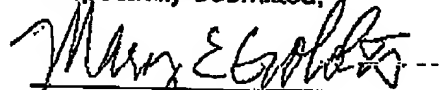
Reconsideration and removal of the anticipation rejection of claims 15 and 20 is respectfully requested in view of the foregoing amendments and remarks.

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### CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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